

### **Remarks**

Claims 17-31 are currently pending in the patent application. One skilled in the art when viewing Arnold would not be lead by Dial to combine virtual color matching with the virtual shopping environment of Arnold, because in every embodiment Dial requires actual physical access to the articles in order to perform color matching. For the reasons and arguments set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The Office Action dated June 23, 2006, indicates that: claims 25-26 stand rejected under 35 U.S.C. § 112(2) as being indefinite; claims 17, 19-22 and 30-31 stand rejected under 35 U.S.C. § 103(a) over Arnold *et al.* (U.S. Patent No. 6,016,504) in view of Dial (U.S. Patent No. 5,537,211); claim 18 stands rejected under 35 U.S.C. § 103(a) in view of Arnold and Dial and in further view of Rose (U.S. Patent No. 5,930,769); and claims 23-29 stand rejected under 35 U.S.C. § 103(a) over Arnold in view of Dial and further in view of Shimizu *et al.* (U.S. Patent No. 6,323,969).

Applicant respectfully traverses the Section 103(a) rejection of claims 17-31 for the reasons stated below, including those stated in the previous response which Applicant hereby incorporates by reference. In response to the Examiner's statement in the Office Action on page 6, last paragraph, that Applicant has not cited a "particular passage in either Arnold or Dial that specifically states such a teaching away," Applicant did cite portions of both references which indicate in detail that the references are incompatible. The Arnold reference is directed to a web-based "virtual outlet" for shopping on the internet, and as such does not have physical access to any of the apparel items. See, *e.g.*, Abstract, Fig. 1A, and col. 5, line 41 to col. 6, line 34. Whereas, the color matching taught by Dial (and as cited by the Examiner) requires physical access to the items in order for color measurement with a photosensor head (see, *e.g.*, col. 6, lines 24-34). The cited references are incompatible because the virtual nature of Arnold teaches away from any physical contact with the apparel items.

Moreover, in response to the statement that "the Examiner did not suggest the bodily incorporation of the physical device of Dial in the web shopping of Arnold, but rather simple color matching," one skilled in the art when viewing Arnold would not be

lead by Dial to add virtual color matching to Arnold because in every embodiment Dial teaches that one must have physical access to the articles to perform color matching. The Examiner has not supplied any evidence of why one skilled in the art would be led by Dial to add virtual color matching to Arnold, and has failed to address how this proposed combination would operate without the physical access to the article. Hindsight reconstruction of the claimed invention, without evidence of motivation, is not permitted.

Applicant further traverses the Section 103(a) rejections because the Examiner fails to present any evidence of motivation to combine the cited references. In the Office Action on page 7, lines 12-13, the Examiner asserts “that Arnold discloses objects displayed having a “smallest difference” in color, as set out in the rejection of claim 17.” However, the cited portions of the Arnold reference merely teach displaying colored objects (see, *e.g.*, col. 7, line 30 to col. 8, line 38), and it is the Examiners asserted motivation for combining the references on page 3 of the Office Action which asserts that the color matching scheme of Dial would provide a “smallest difference” between the colors of two apparel articles. The color matching scheme as taught by Dial requires that there be various articles physically present in order to compare their colors with that of an article (see, *e.g.*, col. 6, lines 24-34). Without other articles being physically present for comparison, a user would not be able to determine “the smallest difference” and would not be able to determine if the difference between two selected articles is acceptable. In response to the Examiner’s statements on page 7, lines 7-9 and lines 17-19 of the Office Action, a skilled artisan would not be motivated to combination the references because the color matching scheme as taught by Dial would not work in the web-based “virtual outlet” of Arnold.

The Examiner attempts to support the rejection by citing a portion of Dial, which consists of how the Dial color matching provides the smallest difference between colors (see, *e.g.*, co.6, lines 49-61). However, for the reasons discussed above, this is only possible when one has physical access to the colored articles that one wishes to compare. The Examiner has provided no motivation of how or why one skilled in the art would be led by Dial to add virtual color matching to Arnold.

Moreover, the proposed modification is also improper because it would frustrate the purpose of Arnold. As is consistent with relevant case law and the M.P.E.P., there is no motivation to modify a reference where the modification would undermine or defeat the purpose of the reference (*see, e.g., In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). The Arnold reference is directed to a web-based “virtual outlet” and as such does not have physical access to any of the apparel items. The color matching taught by Dial requires physical access to the items in order to measure them with a photosensor means (*see, e.g., col. 6, lines 24-34*). There would be no motivation to combine the color matching of Dial with the “virtual outlet” taught by Arnold, because the combination would defeat the purpose of Dial in that it would no longer be a virtual outlet. See M.P.E.P. § 2143.01.

Accordingly, the Section 103(a) rejection of claim 17 is improper and Applicant requests that it be withdrawn.

The Section 103(a) rejections of dependent claims 18-31, which depend from claim 17, are also improper for the reasons discussed above and Applicant requests that they be withdrawn. However, the impropriety of the rejections of certain other limitations in the dependent claims are addressed in greater detail as follows.

Regarding claims 25 and 26, the cited portion of the Shimizu reference does not teach or suggest the limitations directed to automatically indicating for the on-line viewer that the apparel items are color compatible. The Shimizu reference teaches an apparatus and method that allows dissimilar devices to exchange color images and accurately reproduce colors from the sending device to the receiving device despite different color capabilities of the two devices. *See, e.g., Abstract*. The Examiner simply asserts that “automatic indication of acceptability would have been obvious” without citing to any reference that teaches this limitation of the claimed invention (*see, e.g., page 6, lines 1-2*). Without a cite corresponding to each claimed limitation, the Section 103(a) rejection is improper and should be withdrawn.

Regarding claim 29, the cited portion of the Arnold reference does not teach or suggest the limitations directed to selecting an apparel item from a virtual closet maintained for the on-line viewer. The cited portion of Arnold teaches a virtual outlet

that is a series of web pages which are used by customers to view items; in Arnold the items are selected by the customer from merchant websites. See, *e.g.*, page 7, line 30 to page 8, line 44. Arnold does not teach that the items are selected from a virtual closet or that a virtual closet is maintained for the on-line viewer as in the claimed invention.

Applicant further traverses the Section 103(a) rejection of claim 28 because the Office Action has failed to provide any evidence of motivation for modifying the Arnold reference in view of Official Notice. Consistent with M.P.E.P. § 2144.03, Applicant respectfully requests evidence in support of the proposition that such teaching is well known in the prior art and that there is adequate evidence of motivation to combine this prior art with the main reference.

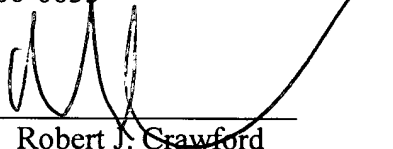
As for the newly added claims 25 and 26, Applicant traverses the Section 112(2) rejections because the claimed limitations are readily discernable in a manner consistent with the requirements of Section 112(2), and are further supported in the specification. Specifically, as consistent with M.P.E.P. § 2173.02, “[t]he requirement to ‘distinctly’ claim means that the claim must have a meaning discernible to one of ordinary skill in the art when construed according to correct principles.” Further, a claim is indefinite “[o]nly when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction.” The Section 112(2) rejection of claims 25 and 26 are improper because the indicated claim term “compatible” would be understood by one of ordinary skill in the art, and is supported by examples in the specification. For instance, the specification describes various example embodiments including that an industry-standardization scheme can be used to determine color compatibility, examples include Exxel Color Match Guide (see, *e.g.*, page 5, lines 23-28). See also M.P.E.P. § 2173.05 The color matching uses an objective standard to determine color compatibility and is not based on individual personal taste as alleged by the Examiner. Accordingly, the Section 112(2) rejections of claims 24-25 are improper and Applicant requests that they be withdrawn.

In view of the above discussion, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. A favorable response is requested. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

CRAWFORD MAUNU PLLC  
1270 Northland Drive, Suite 390  
St. Paul, MN 55120  
651/686-6633

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By:   
Robert J. Crawford  
Reg. No. 32,122